

REMARKS

This paper is presented in response to the Office Action. By this paper, claims 1, 3, 4, 6-13, 17, 21, and 44 are amended, claims 5 and 40-43 are canceled, and new claims 46 and 47 are added. Claims 35-39 were canceled in a previous paper. Claims 1-4, 6-34, and 44-47 are now pending in the application in light of the aforementioned claim amendments.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner, and/or the merits of additional or alternative arguments.

II. Amendments to the Drawings

The Examiner has objected to the drawings for purportedly failing to show each and every feature of the invention specified in the claims. In particular, the Examiner has stated that "the output reflective part and the second external device of claim 22 must be shown" in the drawings. Applicant has amended the drawings herein by adding new Figures 16-23.

Support for new Figure 16 can be found at least at page 8, lines 14-17 of the originally filed specification ("...the reflective surface 125 may be on the output surface 122 of the optical element 120...") and at page 8, lines 17-19 of the originally filed specification ("...output surface 122 may have

more than one reflective surface 125...”). Support for new Figure 17 can be found at least at page 8, lines 14-17 of the originally filed specification (“...the reflective surface 125 may be ... on both the input surface 124 and output surface 122...”). Support for new Figure 18 can be found at least at page 8, lines 17-19 of the originally filed specification (“...the input surface 124...may have more than one reflective surface 125...”). Support for new Figure 19 can be found at least at page 8, lines 17-19 of the originally filed specification (“...the input surface 124...may have more than one reflective surface 125...”) and at page 8, lines 19-21 of the originally filed specification (“...When more than one reflective surface 125 is provided on the optical element 120, selected reflective surfaces may be adapted to reflect the light to...different locations...”). Support for new Figures 20 and 21 can be found at least at page 8, lines 17-19 of the originally filed specification (“...either or both of the input surface 124 or output surface 122 may have more than one reflective surface 125...”). Support for new Figure 22 can be found at least at page 8, lines 14-17 of the originally filed specification (“...the reflective surface 125 may be ... on both the input surface 124 and output surface 122...”) and at page 8, lines 19-21 of the originally filed specification (“...When more than one reflective surface 125 is provided on the optical element 120, selected reflective surfaces may be adapted to reflect the light to...a common location...”). Support for new Figure 23 can be found at least at page 8, lines 14-17 of the originally filed specification (“...the reflective surface 125 may be ... on both the input surface 124 and output surface 122...”) and at page 8, lines 19-21 of the originally filed specification (“...When more than one reflective surface 125 is provided on the optical element 120, selected reflective surfaces may be adapted to reflect the light to...different locations...”).

In light of the new Figures 16-23 submitted herewith, and in particular new Figure 23, Applicant respectfully submits that the objection to the drawings should be withdrawn.

III. Claim Rejections under 35 U.S.C. § 102

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure (“MPEP”)* § 2131.

The Examiner has rejected claims 1-9, 13-17, 19-21, 40-43 under 35 U.S.C. § 102(b) as being anticipated by JP 63089925 to Uehara, Kunio (“*Kunio*”). Inasmuch as claims 5 and 40-43 have been canceled herein, Applicant respectfully submits that the rejection of claims 5 and 40-43 has been rendered moot and should be withdrawn.

With respect to claims 1-4, 6-9, 13-17, and 19-21, Applicant respectfully disagrees but submits that in light of the amendments to these claims made herein, the rejection of these claims should be withdrawn. In particular, Applicant has amended independent claim 1 to require:

...first and second reflective surfaces; and
a photo detector generally facing the input surface of the lens, wherein the first reflective surface of the lens is adapted to reflect a first portion of the light beam toward the photo detector and the second reflective surface of the lens is adapted to reflect a second portion of the light beam toward the photo detector.

(Emphasis added). Support for this amendment to claim 1 can be found, for example, at least at page 8, lines 14-21 of the application. In contrast, the Examiner has not established that *Kunio*, either alone or in combination with any other reference, teaches or suggests the aforementioned limitations in combination with the other limitations of claim 1.

In light of the foregoing, Applicant respectfully submits that the Examiner has not established that *Kunio* anticipates claim 1, at least because the Examiner has not established that each and every element as set forth in claim 1 is found in *Kunio*, because the Examiner has not established that the identical invention is shown in *Kunio* in as complete detail as is contained in amended claim 1, and because the Examiner has not shown that *Kunio* discloses the elements of claim 1 arranged as required by claim 1.

Applicant thus respectfully submits that the rejection of claim 1, as well as the rejection of corresponding dependent claims 2-4, 6-9, 13-17, and 19-21, should be withdrawn.

IV. Rejection of Claims Under 35 U.S.C. § 103

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 10-12 under 35 U.S.C. § 103(a) as being unpatentable over *Kunio*. The Examiner has also rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over *Kunio* in view of U.S. Patent no 5,343,487 to Scott et al. (“*Scott*”). Applicant respectfully disagrees.

Inasmuch as claims 10-12 and 18 depend from amended claim 1, Applicant respectfully submits that claims 10-12 and 18 are allowable for at least the reasons set forth herein in connection with the discussion of claim 1 at section III, and the rejection of those claims should accordingly be withdrawn.

V. New Claims

Applicant notes that new claims 46 and 47 have been added herein. Support for these new claims can be found at least at page 8, lines 14-21 of the application and page 7, lines 3-16 of the application, respectively. Applicant respectfully submits that these claims are in allowable condition by virtue of their dependence from claim 1.

VI. Allowed Claims

The Examiner has objected to claims 44 and 45 as being dependent on a rejected base claim, but has indicated that such claims would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Accordingly, Applicant has amended claim 44 to include all of the limitations of the base claim 40 and intervening claims 41-43.

In connection with the foregoing, Applicant respectfully notes that an objection, by definition, concerns only the form of the claim(s) (as distinguished from the substance of the claim) with respect to which the objection has been posed. *See* Manual of Patent Examining Procedure §§ 706.01, 608.01(n) (emphasis added). Thus, simply rewriting a dependent claim in the manner suggested by the Examiner constitutes only a change to the format of the claim and, without more, has no effect with regard to the substance of the rewritten claim.

Because Applicant has made no change to claim 44 other than to rewrite claim 44 in independent form to include all of the limitations of the base claim and any intervening claims, Applicant respectfully submits that no change has been made herein to the substance of claim 44 and, further, that claim 44, as rewritten herein, and claim 45 which depends from claim 44, are now in condition for allowance.

Applicant acknowledges with thanks the indication of the Examiner that claims 22-34 are allowed, and Applicant also wishes to thank the Examiner for the careful review of those claims.

Applicant submits the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. In general, Applicant agrees with the Examiner that the inventions to which claims 22-34, 44, and 45 are directed are patentable over the cited references, but respectfully disagrees with the Examiner's statement of reasons for allowance as set forth in the Office Action.

Particularly, Applicant submits that it is improper to characterize a single limitation, or subset of limitations, as constituting the basis for allowance of a claim. Rather, the patentability of a claim is properly determined with reference to the claim as a whole. Accordingly, Applicant does not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, claims 22-34, 44, and 45 allowable and Applicant does not make any admission or

concession concerning the Examiner's statements in the Office Action concerning the allowability of claims 22-34, 44, and 45 in view of the cited references.

VII. Docket Number Correction Required

As noted in a paper filed November 8, 2007, Applicant again respectfully notes that the Office Action incorrectly references Attorney Docket No. "H0005285(1139.1156101)." Pursuant to the Change of Attorney Docket Number filed in this case on November 10, 2004, the correct docket number for this case is 15436.442.14. Applicant thus respectfully requests that all applicable USPTO records be updated accordingly, and Applicant further requests that all further communications from the USPTO reference docket number 15436.442.14.

CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-4, 6-34, and 44-47 in this application is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 6th day of July, 2007.

Respectfully submitted,

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